



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/092,277

03/06/2002

Ian Curry

10500.02.0123

7718

23418

7590

07/28/2006

VEDDER PRICE KAUFMAN & KAMMHOLZ
222 N. LASALLE STREET
CHICAGO, IL 60601

EXAMINER

PICH, PONNOREAY

ART UNIT

PAPER NUMBER

2135

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/092,277

Applicant(s)

CURRY, IAN

Examiner

Ponnoreay Pich

Art Unit

2135

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 July 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, ~~the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.~~
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-26.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Response to Arguments

Applicant's arguments submitted after final have been fully considered, but were not persuasive.

Applicant argues the 101 rejection of claim 18. Applicant first notes that the claim is in a means plus function format. The examiner agrees and in rejecting the claim, the examiner referred back to the specification to determine what the means used to perform the functions recited in the claim were. As disclosed in the specification, it appeared that these means could reasonably be interpreted as software. Applicant states that the examiner misstates the wording of a cited portion of the specification in stating that a network element "may be an intranet". The examiner notes that this was a typo and notes that the office action should have stated that a network element "may be **in** an intranet" as this is what is written in the specification (p7, line 13). The typo does not, however, affect the 101 rejection—both hardware and software may be in an intranet.

Applicant notes that as disclosed in pages 7-8 of the specification, a network element includes a transceiver, a decryptor, and an encryptor ... or alternatively that the network element **may** include discrete logic or any suitable combination of hardware, software, and firmware. Addressing the first embodiment of what a network element may be, the examiner notes that on page 8, the specification states that the "transceiver 22 **may be** any suitable circuitry, such as hardware, software, or any suitable combination thereof, that facilitates the receiving and sending of information to and from a sender and other entities. The specification disclosing that a transceiver **may be**

something, does not limit the transceiver to always be that thing. The examiner further notes that the specification does not seem to further define what else a transceiver is if it is not what is defined on page 8, lines 2-4. As such, the examiner believes that a broad but reasonable interpretation of a transceiver is anything that facilitates the receiving and sending of information to and from a sender and other entities. One skilled would appreciate that such a function can be carried out either by software or hardware. Also on page 8, a decryptor 24 and encryptor 28 is defined as "software modules" (lines 10-11). Thus, in one embodiment of a network element in which applicant notes that the network element includes a transceiver, a decryptor, and an encryptor, all three of these elements are reasonably interpreted as software elements in light of what the specification discloses. In the second embodiment where applicant notes that a network element may include digital logic or any suitable combination of hardware, software, or firmware, the examiner notes that this also refers to software per se. One skilled should appreciate that digital logic could be implemented as software per se. Any suitable combination of hardware, software, or firmware can refer to a combination consisting of just software. Thus, it would appear that from what is disclosed in pages 7-8 of the specification, a network element can be implemented as software per se, thus the software means recited in claim 18 are software means per se.

Applicant argues as per claim 24 that the examiner's statement that claim 24 recites a secure communication system which can be implemented as software alone is inconsistent with the specification and thus there is no factual support for such a

Art Unit: 2135

statement. Applicant requests a showing of where in the specification that a secure communication system is merely software per se. Applicant notes that claim 24 requires a network element, a sender and an intended recipient. As per the network element recited in claim 24, this is the software network element recited in claim 1. The examiner has discussed already how the network element is software per se. As to the sender and an intended recipient being software per se, the examiner directs applicant to figure 1 of drawings submitted by applicant. Item 12, shown in figure 1, is a sender. In the figure, applicant gives an example of a sender being a client device. On page 10, paragraph 23 of the specification, applicant also discloses that a sender can be a browser or other suitable application. A client, browser, or other suitable application all are software, as one skilled should appreciate. One skilled should appreciate that a receiver of a client's message/request is a server, which can also be implemented as software per se. Note further that in Figure 1, sender 12 communicates with several receivers; secure distribution servers 16n and an intermediate gateway 18. Recipients 14a and 14n did not appear to ever be explicitly defined in the specification, thus one can also view these recipients as software. Thus, because the sender, receiver, and network element which comprises the system of claim 24 can reasonably be viewed as software alone, claim 24 is directed towards software per se.

As per claim 1, applicant disagreed that the previous amendment changes the scope of the claim as originally existed. The examiner respectfully disagrees. The previous amendment to claim 1 was to add "receiving" to the first limitation and delete "corresponding" from the last limitation. Without "receiving" in the first limitation, the

Art Unit: 2135

examiner interpreted the limitation as meaning that the received encrypted information was for transmission to at least one intended recipient and for transmission to an encrypted secret key. This is not an unreasonable interpretation because one skilled may have interpreted the transmission of the information to the secret key as meaning transmission to where the secret key is located for the purpose of using the secret key to perform further cryptography on the received encrypted information. Applicant adding receiving into the limitation changes the meaning of what is recited so that the limitation now means that the encrypted information was received and an encrypted secret key was received. The meaning of the limitation changed, thus the scope of claim 1 changed. The examiner notes that the limitation could have originally been interpreted in more than one way (meaning that it was indefinite), but as per MPEP 2143.03, if a claim is subject to more than one interpretation, then the examiner should reject the claim over 112, second paragraph and reject the claim over the prior art based on the interpretation that renders the prior art applicable.


Applicant notes that on page 5 of the Final Office action that the examiner is combining the functions of the distribution list exploder (DLE) and group server into just the DLE. Applicant states that Pearlman requires the use of a group server namely certificate server 116, thus the system of Pearlman is distinct from application's claimed invention. The examiner notes that in addition to combining the functions of the DLE and group server into just the DLE, the examiner further stated that the secure distribution server can also include the certificate server 116. As such, it does not flow

Art Unit: 2135

that Pearlman's invention is distinct from applicant's claimed invention because Pearlman requires use of a certificate server.

As per claim 1, applicant argues that Pearlman discloses encrypting the message key with a group secret key as opposed to encrypting the secret key using a public key of a recipient to produce at least one recipient specific secure secret key. The examiner notes that a group secret key is public to all members of the group, thus the value of the key is public to all members of the group. As such, it is a corresponding public key which is used to encrypt the secret/message key.

The rest of applicant's arguments flow from the above traversals. Because applicant's arguments have all been traversed, the examiner respectfully submits that the application currently is not in a condition for allowance.



KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100